

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE SCOTT CAMPBELL

U.S. PATENT APPLICATION NUMBER 10/691,929

TITLE: "SYSTEM AND METHOD FOR RECORDING AND DISPLAYING A GRAPHICAL PATH IN
A VIDEO GAME"

FILING DATE: OCTOBER 22, 2003

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

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RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

A Notification of Non-Compliant Appeal Brief was issued on May 13, 2011. In that *Notification*, it was asserted that the Appeal Brief filed on May 7, 2011 was defective for failure to comply with 37 C.F.R. § 41.37(c).

In response, counsel for the Appellants submits the attached revised appeal brief.

Respectfully submitted,
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June 3, 2011

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REAL-PARTY-IN-INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

The real party in interest is Sony Computer Entertainment America LLC, by way of merger with Sony Computer Entertainment America Inc. by way of assignment from the named inventor of the present application.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

There are no known related appeals or interferences.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

Claims 1-24 and 26-30 are presented for appeal. Claim 25 has been cancelled. Claims 1-24 and 26-30 have all been twice rejected.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

All previously presented amendments have been entered into the record.

SUMMARY OF THE CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))¹

Independent claim 1 as presented for appeal recites:

1. A method for displaying a graphical path in a video game, comprising:
retrieving graphical path data associated with a previous run;
displaying the graphical path data as a visual string of path markers; and
determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

“This invention relates generally to computer-generated images and more particularly to a system and method for recording and displaying a graphical path in a video game.”

Specification, [0001]. “[T]he CPU 112 instructs the GPU 114 to dynamically change graphical content of the path markers as a player character traverses a course associated with the selected time-trial event.” *Specification*, [0038]. “[T]he game software displays the data associated with the previous run, such as previous run data, as a string of dynamically changing colored path markers situated in the game environment.”

Specification, [0017]. “The player character 310 travels along a path designated by positions A-D.” *Specification*, [0032]. “[D]uring the repeat time-trial run the CPU 112 compares a current elapsed time with an elapsed time *t* retrieved from the “best time” sub-cache 210” *Specification*, [0026]. “[T]he CPU 112 (FIG. 1) instructs the GPU 114 (FIG. 1) to change the color of each path marker 1-13 from *c*₀ to another color, dependent upon a “best time” player character state associated with each path marker, if the elapsed time

¹ All references to the *SPECIFICATION* are exemplary and are not intended to be limiting. The present references are made solely to satisfy the requirements of 37 C.F.R. § 41.37(c)(1)(v). No reference is intended—nor should it be construed—as an admission or denial as to any requirement for patentability, including but not limited to those requirements set forth in 35 U.S.C. § 112, ¶ 1 as they pertain to written description and enablement.

t associated with each respective path marker is less than or equal to the elapsed time t_1 ,” *Specification*, [0031].

Independent claim 19 as presented for appeal recites:

19. A computer readable storage medium having embodied thereon a program, the program being executable by a processor to perform a method for displaying a graphical path in a video game, the method comprising:
retrieving graphical path data associated with a previous run;
displaying the graphical path data as a visual string of path markers; and
determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

“This invention relates generally to computer-generated images and more particularly to a system and method for recording and displaying a graphical path in a video game.” *Specification*, [0001]. “CPU 112 (FIG. 1) executes the video game software.” *Specification*, [0021]. “A system of the present invention comprises memory configured to store game instructions.” *Specification*, [0009].

“[T]he CPU 112 instructs the GPU 114 to dynamically change graphical content of the path markers as a player character traverses a course associated with the selected time-trial event.” *Specification*, [0038]. “[T]he game software displays the data associated with the previous run, such as previous run data, as a string of dynamically changing colored path markers situated in the game environment.” *Specification*, [0017]. “The player character 310 travels along a path designated by positions A-D.” *Specification*, [0032]. “[D]uring the repeat time-trial run the CPU 112 compares a current elapsed time with an

elapsed time t retrieved from the “best time” sub-cache 210” *Specification*, [0026]. “[T]he CPU 112 (FIG. 1) instructs the GPU 114 (FIG. 1) to change the color of each path marker 1-13 from c_0 to another color, dependent upon a “best time” player character state associated with each path marker, if the elapsed time t associated with each respective path marker is less than or equal to the elapsed time t_1 ,” *Specification*, [0031].

Independent claim 24 as presented for appeal recites:

24. An electronic entertainment system for displaying a graphical path in a video game, comprising:
a data cache configured to store graphical path data associated with a current video game session and a previous run;
a processor configured to execute instructions stored in memory to:
retrieve the graphical path data associated with the previous run,
to generate a visual string of path markers, and
to determine a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session; and
a display device configured to display the visual string of path markers.

“This invention relates generally to computer-generated images and more particularly to a system and method for recording and displaying a graphical path in a video game.” *Specification*, [0001]. “A system of the present invention comprises a memory configured to store game instructions, a data cache configured to store graphical path data associated with a current video game session and one or more previous game runs, a processor configured to retrieve the graphical path data associated with a selected previous game run and to execute the game instructions for generating a string of path

markers associated with the selected previous game run, and a display device configured to display the string of path markers.” *Specification*, [0009].

“[T]he CPU 112 instructs the GPU 114 to dynamically change graphical content of the path markers as a player character traverses a course associated with the selected time-trial event.” *Specification*, [0038]. “[T]he game software displays the data associated with the previous run, such as previous run data, as a string of dynamically changing colored path markers situated in the game environment.” *Specification*, [0017]. “The player character 310 travels along a path designated by positions A-D.” *Specification*, [0032]. “[D]uring the repeat time-trial run the CPU 112 compares a current elapsed time with an elapsed time t retrieved from the “best time” sub-cache 210” *Specification*, [0026]. “[T]he CPU 112 (FIG. 1) instructs the GPU 114 (FIG. 1) to change the color of each path marker 1-13 from c_0 to another color, dependent upon a “best time” player character state associated with each path marker, if the elapsed time t associated with each respective path marker is less than or equal to the elapsed time t_1 ,” *Specification*, [0031].

Independent claim 30 as presented for appeal recites:

30. A system for displaying a graphical path in a video game session, comprising:
- means for retrieving graphical path data associated with a previous video game session;
 - means for displaying the graphical path data as a visual string of path markers; and
 - means for determining a color of a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of the video game session, an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, and a character state associated with the displayed path marker, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

“This invention relates generally to computer-generated images and more particularly to a system and method for recording and displaying a graphical path in a video game.”

Specification, [0001]. “A system of the present invention comprises a memory configured to store game instructions, a data cache configured to store graphical path data associated with a current video game session and one or more previous game runs, a processor configured to retrieve the graphical path data associated with a selected previous game run and to execute the game instructions for generating a string of path markers associated with the selected previous game run, and a display device configured to display the string of path markers.” *Specification*, [0009].

“[T]he CPU 112 instructs the GPU 114 to dynamically change graphical content of the path markers as a player character traverses a course associated with the selected time-trial event.” *Specification*, [0038]. “[T]he game software displays the data associated with the previous run, such as previous run data, as a string of dynamically changing colored path markers situated in the game environment.” *Specification*, [0017]. “The player character 310 travels along a path designated by positions A-D.” *Specification*, [0032].

“[D]uring the repeat time-trial run the CPU 112 compares a current elapsed time with an elapsed time t retrieved from the “best time” sub-cache 210” *Specification*, [0026]. “[T]he CPU 112 (FIG. 1) instructs the GPU 114 (FIG. 1) to change the color of each path marker 1-13 from c_0 to another color, dependent upon a “best time” player character state associated with each path marker, if the elapsed time t associated with each respective path marker is less than or equal to the elapsed time t_1 ,” *Specification*, [0031].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(C)(1)(vi))

Does a Rule 131 declaration have to comply with 37 CFR 1.47(b)?

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

On December 2, 2008, the U.S. Patent Office issued a non-final office action wherein the independent claims of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over, *inter alia*, U.S. patent number 7,214,133 to Jen et al., which was filed in the United States on May 9, 2003. On June 2, 2009, the Applicants submitted *Response E*, which submitted that “[t]he Jen et al. reference is not eligible for the purpose of rendering a rejection under 35 U.S.C. § 103(a). Jen et al. (outside the aforementioned obviousness rejection) can only qualify as prior art against the present application under 35 U.S.C. § 102(e).” *Response E*, 8. The Applicants further submitted that the presently claimed invention was actually reduced to practice prior to April 8, 2003, which was prior to the filing date of the Jen et al. reference. *Id.*

On October 29, 2009, the Examiner refused to accept *Response E* and its concurrently submitted Rule 131 declaration for (1) failing to comply with Rule 47(b) and (2) contesting certain dates and postings referenced in the Rule 131 declaration. See *October 2009 Rejection*, 2. A notice of appeal was subsequently filed on April 9, 2010. On August 24, 2010, the Applicants submitted a *Request for Continued Examination* including an information disclosure statement identifying a Japanese reference to Namco Ltd. and a rejection from the European Patent Office for an application claiming the priority benefit of the present application. A new final office action followed on September 1, 2010 that repeated “the previous Office Action [*i.e.*, the October 29 rejection] . . . *in toto*.” *September 2010 Rejection*, 2. The present response is considered responsive to the October 2009 and September 2010 rejections in that it addresses the Examiner’s refusal to accept

the previously submitted Rule 131 declaration, which disqualifies the Examiner's use of the Jen reference, and, consequently, obviates the Examiner rejection under 35 U.S.C. § 103(a).

The Examiner first contends that "the affidavit is not compliant with the requirements in 37 CFR 1.131" because "it must also be in compliance with 37 CFR 1.47(b)." *October 2009 Rejection*, 2. The Applicants respectfully disagree as Rule 47(b) concerns the situation "[w]henever all of the inventors refuse to **execute an application for patent**" whereby" a "person to whom an inventor has assigned or agreed in writing to assign the invention . . . may **make application for patent on behalf of and as agent for all the inventors.**" 37 C.F.R. § 1.47(b). A declaration under 37 C.F.R. § 1.131 is not an application for or an execution of an application for patent.

The Applicants note that Rule 131(a) states that:

[w]hen any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim . . . or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

A party qualified under 37 C.F.R. § 1.47 includes "a person to whom an inventor has assigned" —that is, the assignee of the present application. The assignee of the present application designated a person who is "thoroughly familiar with the subject matter, claims, and prosecution history of the present application" and that can "readily and freely testify as to the same." *Declaration Pursuant to 37 C.F.R. § 1.183 & 37 C.F.R. § 1.131*, ¶ 1. Nowhere in Rule 131 is there a requirement that an applicant satisfy the requirements for an inventor that refuses to execute an application; Rule 47 is referenced only in that a "party qualified" under said rule may make said declaration.

Nor does MPEP § 715.04, which governs practice under Rule 131, impose any such requirement as suggested by the Examiner in the October 2009 rejection. MPEP 715.04(I) states—as to *who* may make a declaration under Rule 131—that “[t]he assignee or other party in interest . . . may make an affidavit or declaration under 37 CFR 1.131 . . . when it is not possible to produce the affidavit or declaration of the inventor.” MPEP § 715.05(I)(D). The Applicants therefore contend that the Examiner has imposed requirements on a Rule 131 declaration that are not required by the Office.

Further, the Examiner contends that the evidence provided with the declaration is not persuasive. *October 2009 Rejection*, 3. For example, the Examiner contends that paragraph 13 of the declaration fails to establish actual reduction to practice. While the press release in and of itself does not establish reduction to practice, the press release should be considered in the context of the other evidence presented to establish reduction to practice. For example, it is unlikely that a company would announce the forthcoming commercial release or demonstration of a product when, in fact, it is not imminently read for commercial release or demonstration. This is especially true when the press release was made a little more than a month from the public display of the product at one of the world’s largest video game expositions—the E3 Conference in Los Angeles (see paragraph 15). And as further indicated in paragraph 15, while that commercial / public release of the product was four days after the filing date of the reference in question, common sense requires that a video game—which takes years to develop—cannot be conceived of, developed, coded, and debugged with a 4 day time frame. The press release that pre-dated the Jen reference coupled with the product release that followed the Jen reference by a mere 4 days requires the adoption of common sense that the product was conceived of prior to Jen.

Still further, paragraph 14 provides video evidence of the actual release of the Downhill Domination product. The Examiner contends, however, that “web-links change over time.” *October 2009 Rejection*, 3. While this is possible (theoretically), there is no

evidence that this is the case. This possibility, too, calls into serious question *why* someone would change the links concerning the state of game development at a certain date with a different video *after the fact* when that new video would be inaccurate. The Examiner's rejection, therefore, is based in inherency or mere possibility. If that is the case, then the Applicant contends that the proper basis for establishing inherency has not been met as mere possibility does not meet the standard set forth by the Manual of Patent Examining Procedure and the various Board and Federal Circuit decisions that have since interpreted the same.

CONCLUSION AND REQUESTED RELIEF

The Applicant's representatives have evidenced that the presently claimed invention was actually reduced to practice prior to the filing date of the Jen et al. reference. Jen et al. is, therefore, not prior art against the present application. Absent the Jen et al. reference, the Examiner has failed to disclose the presence of each and every element of the presently claimed invention in the prior art. The Examiner, therefore, has failed to make a *prima facie* case of obviousness and the rejection is overcome.

The Applicant respectfully requests the passage of the present application to allowance. The Examiner is invited to contact the Applicant's undersigned representative with any questions concerning this matter.

Respectfully submitted,
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June 3, 2011

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CLAIMS APPENDIX

THE PENDING CLAIMS ARE AS FOLLOWS:

1. A method for displaying a graphical path in a video game, comprising:
 - retrieving graphical path data associated with a previous run;
 - displaying the graphical path data as a visual string of path markers; and
 - determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of the player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.
2. The method of claim 1, wherein determining the color for a displayed path marker includes selecting a first color for the displayed path marker when the elapsed time associated with the displayed path marker is greater than the elapsed time of the current video game session.
3. The method of claim 2, wherein determining the color for a displayed path marker includes selecting a second color for the displayed path marker based upon a character state associated with the displayed path marker when the elapsed time associated with the displayed path marker is less than or equal to the elapsed time of the current video game session.
4. The method of claim 3, wherein the character state associated with the displayed path marker is an “on the ground” state.
5. The method of claim 3, wherein the character state associated with the displayed path marker is an “airborne” state.
6. The method of claim 3, wherein the character state associated with the displayed path marker is a “crashed” state.
7. The method of claim 1, wherein determining the color for a displayed path marker includes selecting a color based upon a character state associated with the displayed path marker.
8. The method of claim 1, wherein the previous run is a “best time” run.

9. The method of claim 1, wherein the previous run is a “worst time” run.
10. The method of claim 1, wherein the previous run is an “average time” run.
11. The method of claim 1, wherein the previous run is a run selected from one or more previous runs.
12. The method of claim 1, further comprising generating current graphical path data associated with the current video game session.
13. The method of claim 12, further comprising storing the current graphical path data as “best time” run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous “best time” run.
14. The method of claim 12, further comprising storing the current graphical path data as “worst time” run graphical path data when a total elapsed time of the current video game session is greater than a total elapsed time associated with the previous run.
15. The method of claim 12, further comprising utilizing the current graphical path data in determining an “average time” run graphical path data.
16. The method of claim 1, wherein the visual string of path markers are generated at a substantially equal-distance from each other.
17. The method of claim 1, wherein retrieving graphical path data includes retrieving the graphical path data associated with the previous run from a data cache.
18. The method of claim 1, wherein retrieving graphical path data includes retrieving the graphical path data associated with the previous run from a memory card.
19. A computer readable storage medium having embodied thereon a program, the program being executable by a processor to perform a method for displaying a graphical path in a video game, the method comprising:
 - retrieving graphical path data associated with a previous run;
 - displaying the graphical path data as a visual string of path markers; and
 - determining a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

20. The computer readable storage medium of claim 19, wherein determining the color for the displayed path marker includes selecting a first color for the displayed path marker when the elapsed time associated with the displayed path marker is greater than the elapsed time of the current video game session.

21. The computer readable storage medium of claim 20, wherein determining the color for the displayed path marker includes selecting a second color for the displayed path marker based upon a character state associated with the displayed path marker when the elapsed time associated with the displayed path marker is less than or equal to the elapsed time of the current video game session.

22. The computer readable storage medium of claim 19, further comprising generating current graphical path data associated with the current video game session.

23. The computer readable storage medium of claim 22, further comprising storing the current graphical path data as the “best time” run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous “best time” run.

24. An electronic entertainment system for displaying a graphical path in a video game, comprising:

- a data cache configured to store graphical path data associated with a current video game session and a previous run;

- a processor configured to execute instructions stored in memory to:

- retrieve the graphical path data associated with the previous run,

- to generate a visual string of path markers, and

- to determine a color for a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of a current video game session and an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session;
- and

- a display device configured to display the visual string of path markers.

26. The electronic entertainment system of claim 24, wherein the processor is configured to further execute instructions stored in memory to determine a color for a displayed path marker of the visual string of path markers based upon a character state associated with the displayed path marker.

27. The electronic entertainment system of claim 24, further comprising a memory card and coupled to the processor, the memory card configured to store graphical path data associated with the previous run.

28. The electronic entertainment system of claim 24, wherein the processor is configured to execute instructions stored in memory to:

generate graphical path data of the current video game session; and

store graphical path data of the current video game session in the data cache.

29. The electronic entertainment system of claim 24, wherein the processor is configured to further execute instructions stored in memory to store current graphical path data of the current video game session as “best time” run graphical path data when a total elapsed time of the current video game session is less than a total elapsed time associated with a previous “best time” run.

30. A system for displaying a graphical path in a video game session, comprising:

means for retrieving graphical path data associated with a previous video game session;

means for displaying the graphical path data as a visual string of path markers;
and

means for determining a color of a displayed path marker of the visual string of path markers based upon an elapsed time from a starting point to a current location of a player character of the video game session, an elapsed time from a starting point to the current location of a player character associated with the displayed path marker from the previous run and recorded for each point in the path, and a character state associated with the displayed path marker, wherein the current location is after the starting line but prior to the finish line for a course being traversed in the current video game session.

EVIDENCE APPENDIX
37 C.F.R. § 41.37(c)(1)(ix)

Not applicable in the present appeal.

RELATED PROCEEDINGS APPENDIX
37 C.F.R. § 41.37(c)(1)(x)

Not applicable in the present appeal.